

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte RICHARD ROTHKOPF

Appeal No. 2004-0082
Application No. 09/520,798

ON BRIEF

Before FLEMING, LEVY, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-13, 15-21, and 23-25, which are all the claims remaining in the application.

We reverse.

BACKGROUND

The invention relates to method and apparatus for offering a promotional award to a visitor to an electronic commerce site. A site visit is detected, and the visitor is granted a promotional award in accordance with stored rules. Claim 1 is reproduced below.

1. An electronic commerce apparatus for offering a promotional award to a visitor of an electronic commerce site, comprising:

a connection to a distributed communication network;

a promotional awards storage area, including a customer identifier storage that contains unique identification information for each visitor to said site, and a visitor parameter storage that contains information pertaining to prior visits to said site by visitors identified in said customer identifier storage; and

an awards rule storage that stores rules for crediting awards to visitors of said site according to information stored in said visitor parameter storage;

wherein a visitor of said site is granted a promotional award by retrieving visitor parameter information from said visitor parameter storage corresponding to customer identification information stored in said customer identifier storage in response to visitor identification information provided to said apparatus upon visitor access to said site, and applying retrieved visitor parameter information to award crediting rules retrieved from said awards rule storage.

The examiner relies on the following references:

Reed et al. (Reed)	5,862,325	Jan. 19, 1999
Leason et al. (Leason)	6,251,017 B1	Jun. 26, 2001 (filed Apr. 21, 1999)

Claims 1-13, 15-21, and 23-25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Leason and Reed.

We refer to the Final Rejection (Paper No. 7) and the Examiner's Answer (Paper No. 14) for a statement of the examiner's position and to the Brief (Paper No. 12) and the Reply Brief (Paper No. 15) for appellant's position with respect to the claims which stand rejected.

OPINION

We reverse the Section 103 rejection of claims 1-13, 15-21, and 23-25 over Leason and Reed for the reasons expressed by appellants in the briefs. In particular, we agree with appellant (Brief at 6-10) that the rejection fails to set forth a sufficient basis to show prima facie obviousness of the claimed subject matter.

Obviousness is a question of law based on findings of underlying facts. See Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). The allocation of burdens requires that the USPTO produce the factual basis for its rejection of an application under 35 U.S.C. § § 102 and 103. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (citing In re Warner, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967)). The one who bears the initial burden of presenting a prima facie case of unpatentability is the examiner. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Appellant contends (Brief at 6) that the rejection "uses an erroneous and incomprehensible standard for determining obviousness...." The statement of the rejection applied against claim 1, for example, takes up four pages of the Answer. The

rejection, however, appears to allege that material in Leason "shows elements that suggest" language reproduced from the principal portion of claim 1. Further, the rejection alleges that it would have been obvious to the artisan that "the disclosure" of Leason "would have been selected in accordance with the elements and limitations of claim 1...." Reed in view of Leason is deemed to show "elements that suggest," again, a reproduction of the principal portion of claim 1. The comments at the bottom of page 7 of the Answer, however, indicate that perhaps Reed is relied upon only as suggesting "parameter storage modifications" to be applied to the "lottery award system" of Leason.

The Section 103 rejection fails to set forth adequate findings that identify the elements deemed to "suggest" the claimed subject matter. While the disclosures of the references may "suggest" the claimed subject matter to the examiner, the reasoning with respect to why the elements are deemed to suggest the claimed limitations must be set forth in the record in order to establish a prima facie case for unpatentability. The rejection thus fails, at the least, to ascertain the differences between the prior art and the claims in issue. Cf. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (in a determination of unpatentability "the Board must point to some concrete evidence in the record in support of...[the]...findings").

We would, in many cases, remand the application for a clearer statement of the rejection. For substantially the same reasons expressed by appellant in the Reply Brief, however, we are of the opinion that the applied prior art cannot teach or suggest all the

limitations of any one of independent claims 1, 10, or 19. We therefore reverse, rather than remand.

The rejection of claims 1-13, 15-21, and 23-25 under 35 U.S.C. § 103 as being unpatentable over Leason and Reed is reversed.

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